

III. REMARKS

Claims 1-35 are pending in this application. By this amendment, claims 1, 3, 7, 13, 16, 22, 26 and 31 have been amended. No new matter is believed added. Applicants do not acquiesce in the correctness of the rejections and reserve the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicants reserve the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the amendment and the following remarks is respectfully requested.

In the Office Action, claim 3 is objected to because of informalities. Claims 1-3, 5, 6 and 16-35 are rejected under 35 U.S.C. §112, second paragraph as allegedly being indefinite. Claims 1-15 are rejected under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. Claims 1, 2, 4-9 and 11-35 are rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Puri (U.S. 6,064,982), hereafter "Puri." Claims 3 and 10 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Puri.

A. OBJECTION OF CLAIM 3

The Office has objected to claim 3 because of informalities. Applicants have amended claim 3 to recite, "step of weighting" as suggested by the Office. Accordingly, Applicants request that the objection be withdrawn.

B. REJECTIONS OF CLAIMS 1-3, 5, 6 and 16-35 UNDER 35 U.S.C. §112

The Office has asserted that claims 1-3, 5, 6 and 16-35 are indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Office asserted that the body of claims 1 and 16 does not accomplish the stated objective in the preamble, which is to analyze the application needs of an entity, and that claims 16, 22, 26 and 31 do not recite any interaction between the inventory system and the query system.

Applicants have amended claims 1 and 16 to recite “. . . wherein the set of questions are tailored to assess the software application needs of the business entity,” so that the questions, responses and analysis are clearly related to the entity software application needs. Applicants have amended claims 16, 22, 26 and 31 to recite “a query system for providing a set of questions and weighted responses related to an entity software application *in the inventory system*,” so that the inventory system expressly interacts with other component within the overall system. Applicants assert that these amendments further clarify the alleged claims in the present application. Accordingly, Applicants request that the rejections be withdrawn.

C. REJECTIONS OF CLAIMS 1-15 UNDER 35 U.S.C. §101

The Office has rejected claims 1-15 for allegedly being directed to non-statutory subject matter. Applicants have amended claims 1, 7 and 13 to recite a “*computer-implemented method*.” Claims 2-6, 8-12 and 14-15 respectively depend from the independent claims 1, 7 and 13. Applicants assert that these amendments further direct the invention to statutory subject matter. Accordingly, Applicants request that the rejections be withdrawn.

D. REJECTIONS OF CLAIMS 1, 2, 4-9 and 11-35 UNDER 35 U.S.C. §102(e)

With regard to the 35 U.S.C. §102(e) rejection over Puri, Applicants assert that Puri does not teach each and every feature of the claimed invention. For example, with respect to currently amended claim 1, Applicants submit that Puri fails to teach, among other things, a computer-implemented method for analyzing *software* application needs of a *business* entity. This amendment is evident in and supported by page 1, line 11 to page 2, line 20, *inter alia*, page 1, lines 13-15 (“*business* entities are now seeking to offer their services on-line, which often requires specific *software* applications”); page 2, lines 9-10 (“... such attempts fail to optimize an application portfolio based on the particular *business* entity’s business strategy”). Applicants also submit that Puri fails to teach, but not limited to, “formulating . . . questions related to an entity software application based on . . . the *software application needs* of the entity.”

In contrast, Puri makes *no* attempts or efforts to analyze software application needs of a business entity. In column 1, lines 6-8, Puri describes his invention as “relat[ing] to *product* needs assessment” and more particularly, “relat[ing] to a tool that assists company representatives in configuring a *product* to meet a *customer’s needs*. ” The problem faced by Puri is that “it is often difficult for *sales and marketing* personnel to keep their *customer’s* abreast of current company *product offerings*, configurations, options, and pricing” (column 1, lines 12-14). Therefore, Puri tries to “provide an intelligent *sales* tool that provides field personnel/*customers* with access to current *product* information while guiding them through the needs assessment and product selection/configuration process” (column 1, lines 38-42).

In addition, apparently, Puri does not disclose: the claimed steps of “inventorying a set of entity *software applications*,” and the claimed steps of “formulating a set of questions related to

an entity *software* application based on a business strategy corresponding to the *software application needs* of the entity.” Therefore, Applicants respectfully submit that Puri does not anticipate independent claim 1 (and similarly independent claims 7, 13, 16, 22, 26 and 31) of the present invention. Accordingly, Applicants respectfully request that the Office withdraw its rejections.

With respect to dependent claims, Applicants herein incorporate the arguments presented above with respect to the independent claims from which the claims depend. Furthermore, Applicants submit that all dependant claims are allowable based on their own distinct features. Since Puri does not teach each and every feature of the claimed invention, Applicants respectfully request withdrawal of these rejections based under 35 U.S.C. §102(e).

E. REJECTIONS OF CLAIMS 3 and 10 UNDER 35 U.S.C. §103(a)

With regard to the 35 U.S.C. §103(a) rejection over Puri, Applicants assert that Puri fails to teach or suggest each and every feature of the claimed invention. Applicants assert that the Office’s factual assertion, which amounts to Official Notice, is not properly based upon common knowledge. For example, Applicant asserts that the step of assigning a value for each possible response to the set of questions is not obvious to one skilled in the art as asserted by the Office. Accordingly, Applicants respectfully request that the Office support the finding with references that show these features.

With respect to the Office’s other arguments regarding dependent claims, Applicants herein incorporate the arguments presented above with respect to the independent claims from which claims 3 and 10 depend. Furthermore, Applicants submit that claims 3 and 10 are

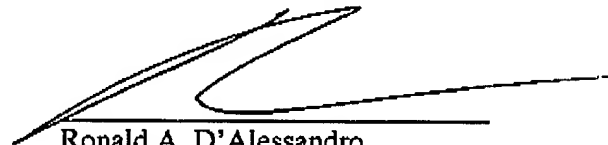
allowable based on their own distinct features. Since Puri does not teach each and every feature of the claimed invention, Applicants respectfully submit that Puri does not render claims 3 and 10 obvious, and request withdrawal of these rejections based under 35 U.S.C. §103(a).

IV. CONCLUSION

In light of the above, Applicants respectfully submit that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the number listed below.

Respectfully submitted,

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